

REMARKS

I. The Requirement for Information is Untimely Under 37 C.F.R. § 1.105

At page 2 of the Office Action dated October 29, 2007, the Office requires additional information from the Applicants.

The Requirement is untimely Under 37 C.F.R. § 1.105 because the Office had an opportunity to require additional information within the scope of the present requirement in the non-final Office Action issued on June 14, 2006 and the non-final Office Action issued February 2, 2007, wherein the Office explicitly cited BioCentury Part II in form PTO-892. The Office failed to require additional information prior to or with the first Office Action on the merits. At MPEP 704.11(b) the Office interprets 37 C.F.R. § 1.105 to mean, “a requirement may be made at any time *once the necessity for it is recognized and should be made at the earliest opportunity after the necessity is recognized*. The optimum time for making a requirement is *prior to or with a first action on the merits* because the examiner has the maximum opportunity to consider and apply the response.” Emphasis added.

However, in order to expedite prosecution the Applicants herewith provide the requested information.

II. Required Information

At page 2 of the Office Action dated October 29, 2007, the Office requires additional information from the Applicants based on the allegation that the

“prior art of BioCentury Part II states that ImmunoGen reported treatment with My9-6-DM1 and with respect to humanizing the My9-6 antibody, data were presented at the Engineered Antibodies Accelerating Drug Discovery & Development Conference in

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Philadelphia. Thus, the record suggests the Applicants likely have access to information necessary for a more complete understanding of the invention and its relevant context and the details of such information may be relevant to the issue of patentability and thus, shows the need for information in addition to that already submitted by the applicants.”

The Office explicitly premises the Requirement for Information on a reference first cited almost a year ago, on February 2, 2007. The disclosure of a reference is limited to that which it contains. Vis-à-vis the outstanding application, the cited reference alone discloses the information now required by the Office therefore, the Requirement for Information is duplicative and lacks proper legal ground.

However, in order to advance prosecution the Applicants herewith submit the following Response to the Office’s interrogatories.

Interrogatory 1. Was the ImmunoGen report regarding treatment with My-9-6-DM1 limited to BioCentury Part II?

No.

Interrogatory 2. Was the treatment with My9-6-DM1 reported elsewhere and if so, what additional reports were made regarding the treatment with My9-6-DM1, where were they reported, what is the substance of the reports, and are copies available?

Reports regarding treatment with the My-9-6-DM1 antibody were made at the Proceedings of American Association of Cancer Research, 43, 912 (April 6-10, 2002)

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and at the 1st International Congress on Targeted Therapies held in Washington, DC from August 16-18, 2002. Copies are available.

Although copies are not requested by the Office, in order to advance prosecution the Applicants provide copies of relevant portions of the reports in Appendix A and B, respectively, attached herewith.

Interrogatory 3. What was the date of the presentation at the Engineered Antibodies Accelerating Drug Discovery & Development Conference in Philadelphia?

October 22, 2001.

Interrogatory 4. What data were presented at the Engineered Antibodies Accelerating Drug Discovery & Development Conference in Philadelphia? Were sequences presented?

The slides relevant to the outstanding application are attached herewith as Appendix C. No sequences were disclosed.

Interrogatory 5. Are copies of the data presented at the Engineered Antibodies Accelerating Drug Discovery & Development Conference in Philadelphia available?

The slides relevant to the outstanding application concerning the data presented at the Engineered Antibodies Accelerating Drug Discovery & Development Conference are available.

Although a copy is not requested by the Office, in order to advance prosecution the Applicants voluntarily provide copies of relevant portions of the report in Appendix C, attached herewith.

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**Interrogatory 6. Were there any restrictions placed on copying or note taking
at the Engineered Antibodies Accelerating Drug Discovery & Development
Conference in Philadelphia?**

The Applicants do not know the answer to this interrogatory.

Some of the required information contained in the Appendices is displayed in color. If the USPTO's "paperless" system does not allow the Office to view the information in color, Counsel would be glad to have color copies of the information hand carried to the Examiner for his convenience.

In view of the above, allowance of this application is now believed to be in order, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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